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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,414	12/19/2000	Samuel N. Zellner	00138	3676

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EXAMINER

DAVIS, TEMICA M

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 04/21/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/740,414

Applicant(s)

ZELLNER ET AL.

Examiner

Temica M. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed February 6, 2004 have been fully considered but they are not persuasive.

Applicant argues that Baker, taken alone or in combination with other prior art, fails to disclose transferring identity information for the user to a third party without disclosing the location information for the user to the third party.

Applicant further states that although Baker teaches that the location area identification is an optional parameter of the origination request, Baker is only disclosing that using location area identification need not be one of the ways to determine the location of the user.

The examiner partially agrees with the applicant, in that sending the location information to a third party is an optional parameter. However, although the location of the user is inherently known in the system, the location information (i.e., cell and cell sector identification) is not sent to the third party (i.e., WSN) (col. 8, lines 17-25 and col. 8, lines 37-52). As admitted by the applicant, Baker discloses that sending the location information to the WSN is optional.

Further, based on the claim language regarding the location information, the only requirement is that the identity information for the user be transferred to a third party without disclosing the location information. In one embodiment, Baker does meet this requirement. Baker shows that at the time the identity

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information for the user is transferred to the WSN, the location information for the user is not disclosed to the third party (col. 8, lines 17-25 and col. 8, lines 37-52).

Based on the remarks above, it has been shown that Baker, taken alone or in combination meets the claimed language. Therefore, the rejection stands as set forth below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 8, 9, 14 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Baker, U.S. Patent No. 6,505,046

Regarding claim 1, Baker discloses a method of providing a location-blocking service comprising: obtaining identity information for a user operating a wireless communication device; obtaining location information for the user; and transferring the identity information for the user to a third party without disclosing the location information for the user to the third party (i.e., since location information is optional) (col. 8, lines 11-52).

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Regarding claim 3, Baker discloses the method of claim 1, wherein the third party is an advertiser desirous of sending an advertisement to the wireless communication device (col. 7, lines 62-64)

Regarding claim 8, Baker discloses the method of claim 1, wherein obtaining the location information for the user includes: monitoring one or more signals transmitted by the wireless communication device operated by the user; and determining the location of the user based on an analysis of the one or more signals (col. 7, lines 28-37).

Regarding claim 9, Baker discloses the method of claim 1, wherein obtaining the location information includes receiving the information about the location of the user supplied by the wireless communication device (col. 7, lines 28-37).

Regarding claim 14, Baker discloses a method to provide information about identity of a user operating a wireless communication device, comprising: obtaining identity information for the user; identifying the location of the user of the wireless communication device; and transmitting the identity information for the user to a subscriber desirous of sending an advertisement to the wireless communication device, wherein the transmission of the identity information excludes disclosure of the location of the user (col. 7, lines 62-64, col. 8, lines 11-52).

Regarding claim 18, Baker discloses the method of claim 14, wherein identifying the location of the user includes: monitoring one or more signals

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transmitted by the wireless communication device; and determining the location of the user based on an analysis of the one or more signals (col. 7, lines 28-37).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 11, 15, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker.

Regarding claims 2, 10, 15 and 19, Baker discloses the methods of claims 1 and 14 as described above. Baker, however, fails to disclose charging fees to various entities for performing services. The examiner contends that at the time of invention, such a feature would have been obvious to a person of ordinary skill in the art since resources would have to be used in order to provide the desired services to the user/third party. As such, fees should be charged in order that the network providing the resources for the services can profit.

Regarding claims 11 and 20, Baker discloses the methods of claims 1 and 14 as described above. Baker, however, fails to disclose disclosing location information of a user in the event of an emergency situation.

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The examiner contends, however, that at the time of invention, such a feature would have been obvious to a person of ordinary skill in the art to ensure the safety of the user of the mobile station.

6. Claims 4, 5, 7, 16 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Baker in view of Stewart, U.S. Patent No. 6,546,257.

Regarding claims 4 and 16, Baker discloses the method of claims 1 and 14 as described above and further discloses requesting the user to provide information about the identity of the user (col. 8, lines 11-52). Baker, however, fails to disclose, wherein obtaining the identity information for the user includes storing the information about the identity of the user.

In a similar field of endeavor, Stewart discloses providing promotional material based on repeated travel patterns. Stewart further discloses wherein obtaining the identity information for the user includes storing the information about the identity of the user (col. 10, lines 52-67).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Baker with the teachings of Stewart since such storing of the location would help the advertiser in determining when to transfer certain advertisements based on the repeated travel patterns of a user.

Regarding claim 5, the combination of Baker and Stewart discloses the method of claim 4, wherein requesting the user to provide the information about the identity of the user is performed when the user signs up for a communication

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service that allows the user to operate the wireless communication device (Baker, col. 6, lines 47-49).

Regarding claim 7, the combination of Baker and Stewart discloses the method of claim 4, wherein storing the information about the identity of the user includes maintaining a database to store the identity information therein (Stewart, col. 10, lines 52-67).

Regarding claim 17, the combination of Baker and Stewart discloses the method of claim 16, wherein obtaining the data from the user is accomplished inherently when the user signs up for a communication service that allows the user to operate the wireless communication device (Baker, col. 6, lines 47-49).

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baker, Stewart and Fomukong et al (Fomukong), U.S. Patent No. 5,560,461.

Regarding claim 6, the combination of Baker and Stewart discloses the method of claim 4 as described above. The combination, however, fails to disclose wherein requesting the user to provide the information about the identity of the user is performed when the user signs up for the location-blocking service.

In a similar field of endeavor, Fomukong discloses authorized location reporting in a paging system. Fomukong further discloses requesting the user to provide the information about the identity of the user is performed when the user signs up for the location-blocking service (col. 2, lines 1-11, col. 4, lines 54-67).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Baker and Stewart with the

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teachings of Fomukong to ensure that the location of the user is only divulged to a third party based on a users desire.

8. Claims 12, 13 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker and Fomukong.

Regarding claim 12, Baker discloses the method of claim 1 as described above. Baker, however, fails to disclose allowing the user to unblock disclosure of the location information to the third party.

Fomukong discloses a system which allows a user to block or unblock disclosing location information to third parties (col. 4, lines 46-62).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Baker with the teachings of Fomukong to ensure that the location of the user is only divulged to a third party based on a users desire.

Regarding claim 13, the combination of Baker and Fomukong discloses the method of claim 12 as described. The combination, however, fails to disclose wherein the user unblocks disclosure of the location information over the Internet.

The examiner contends however, that at the time of invention, such a feature would have been obvious to a person of ordinary skill since it is known in the art that mobiles phones are Internet-capable.

Regarding claim 21, Baker discloses the method of claim 14 as described above. Baker, however, fails to disclose allowing the user to unblock over the Internet the disclosure of the location of the user to the subscriber.

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Fomukong discloses a system which allows a user to block or unblock disclosing location information to third parties (col. 4, lines 46-62).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Baker with the teachings of Fomukong to ensure that the location of the user is only divulged to a third party based on a users desire.

The combination, however, fails to disclose wherein the user unblocks disclosure of the location information over the Internet.

The examiner contends however, that at the time of invention, such a feature would have been obvious to a person of ordinary skill since it is known in the art that mobiles phones are Internet-capable.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Davis whose telephone number is (703) 306-5837. The examiner can normally be reached Monday-Friday (alternate Fridays) from 9:00am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika Gary can be reached on (703) 308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Temica M. Davis
Examiner
Art Unit 2681

April 16, 2004

